

## REMARKS

Claims 22-28 remain pending in the present application. Claims 25-28 are withdrawn from consideration at this time. The claims have not been amended in response to the Office Action.

### REJECTION UNDER 35 U.S.C. § 103

**Claims 22 and 23 are rejected** under 35 U.S.C. § 103(a) as being unpatentable over **Tompkins** (U.S. Patent No. 4,138,867). This rejection is respectfully traversed.

The Examiner based his rejection on **Tompkins** which, in the Examiner's opinion, discloses a clamping mechanism with "almost every structural limitation" (emphasis added). However, **Tompkins** lacks a non-releasable one-way rotary clutch positioned between the rod and the clamping arm. The Examiner then

takes Official Notice that non-releasable one-way rotary clutches are old and well known in the art and provide various well known benefits including enabling rotational movement in one direction while preventing undesired movement in an opposite direction. Such clutches are often provided on one-time use devices. (emphasis added)

**Tompkins** discloses a pair of handcuffs "having two wings connected by means of a hinge. . . . A detent or pawl, cam operated and spring and pin biased, engages and disengages teeth to alternately hold the shackle in place and to allow it to swing open." (Abstract, emphasis added) The concept of adding a one-way non-releasable clutch to **Tompkins** goes against its teachings, as well as the fact that there is absolutely no suggestion or motivation to combine these teachings.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed

invention was made" (emphasis added) because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371; 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). Here, there is no incentive to combine *Tompkins* with the Official Notice of the Examiner for the simple reason that adding a one-way non-releasable clutch to *Tompkins* is inconceivable, due to the fact that the addition of the clutch makes *Tompkins* unsatisfactory for its intended purpose.

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900; 221 USPQ 1125 (Fed. Cir. 1984). Adding the one-way clutch to *Tompkins* modifies it such that it is unsatisfactory for its intended purpose. *Tompkins* is designed to be locked and released numerous times. This enables the handcuffs to be used more than once. Because the Examiner's modification makes *Tompkins* unsatisfactory for its intended use, the combination of *Tompkins* with the Official Notice by the Examiner is inappropriate and there is no suggestion or motivation to make this combination.

To establish a *prima facie* case of obviousness, the Examiner must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *In re Fine*, 837 F.2d at 1074; 5 USPQ2d at 1598 (Fed. Cir. 1988).

There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *Id.* at 1075; 5 USPQ2d at 1599.

A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the references, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant.

*In re Gurley*, 27 F.3d 552, 553; 31 USPQ2d 1130, 1131 (Fed. Cir. 1994).

If when combined, the reference "would produce a seemingly inoperative device," then they teach away from their combination." *In re Sponnoble*, 405 F.2d 578, 587; 160 USPQ 237, 244 (CCPA 1969); see also *In re Gordon*, *supra* at 902; 221 USPQ at 1127. Here, there is no motivation to combine the Examiner's Official Notice with *Tompkins* because the modification of *Tompkins* would render its handcuffs inoperable for their intended purpose of multiple uses.

Thus, Applicants believe Claim 22 patentably distinguish over the art of record. Likewise, Claim 23, which ultimately depend from Claim 22, is also believed to patentably distinguish over the art of record.

Reconsideration of the rejection is respectfully requested.

**REJOINDER**

Applicants respectfully request the rejoinder of Claims 25-28.

**CONCLUSION**

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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